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### REMARKS

This is in response to the Office Action mailed on January 24, 2007. Claims 19-36 are pending in the application and were rejected. With this response, no amendments are made to the claims, and no claims are added or canceled. Rather, Applicant respectfully traverses the rejection of the Examiner.

#### **Independent Claims 19 and 28**

The independent claims, i.e., claims 19 and 28, have been rejected under 35 U.S.C. 103(a) as being unpatentable over the article "WebTurboTax Brings the Full Power of TurboTax to the Web, or simply "WebTurboTax;" in view of United States, Internal Revenue Bulletin Announcement 99-79; and in further view of the article "Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing." Applicant traverses this rejection.

The WebTurboTax article does not teach the particular features of the claims as stated in the Office Action. For example, the claimed feature of "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies an expected tax form the user is expected to file" is not shown in the reference. According to the Office Action, this feature is taught in paragraph 4-6 of the article, but this is incorrect. Instead, paragraph 5 in the article teaches or suggests a user selecting a tax return, which then brings up an Interview Navigator to help fill-out the selected form. In paragraph 6, a user creates a user name and secure password to bring up the tax return from any computer.

The teachings of paragraphs 4-6 are different from the claimed features of "an electronically stored profile" where "the profile identifies an expected tax form the user is expected to file." First, the article contains no claimed feature of "an electronically stored profile" that "identifies an expected tax return." Rather, no mention is made in the article how a tax return is selected. And there is no mention of an electronically stored profile for a user in a customer database. The article suggests only a user selecting a tax return and then filling it out with the Interview Navigator feature.

Further, a stored and later accessed partially completed tax return taught in the article at paragraph 6 can not satisfy the "profile" feature of the claims. This is because in

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claimed features "prompting the user, on a client computer, for additional tax-related data" such as the non-completed portions of the partially completed tax return must satisfy the claimed feature of "the addition tax-related data is not included in the profile."

Furthermore, the prior art does not suggest a modification of the article to include these claimed features because it does not recognize the problem facing Applicant. The article is directed to a "consumer tax preparation service" as set forth in paragraph 1, while the present independent claims are not so limited. Consumer tax, or taxation of individuals, is a relatively simple component of the actual tax system. Consumer tax returns are finite in number and are relatively easy to prepare. They do not need to rely on a "profile [that] identifies an expected tax form the user is expected to file" as claimed because the choices are limited and can be determined by completing the Interview Navigator. Because the prior art fails to recognize the problem facing the Applicant, it cannot suggest a solution.

Therefore, no reasonable Interpretation of the article exists that can teach or suggest the claimed features of "an electronically stored profile" where "the profile identifies an expected tax form the user is expected to file."

Applicant also submits that the IRS Bulletin 99-79 used in this combination does not qualify as prior art under 35 U.S.C. 102(b) because it is not more than one year before the filing date of the application. Even if the IRS Bulletin did qualify as prior art, it would be ineffective in the combination because it at least does not teach and the prior art does not suggest a modification so that the IRS Bulletin can include the missing teachings of the WebTurboTax article.

Applicant also submits that the article "Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing" is not properly combined with the first two references in the rejection, and thus is improperly included. The Office Action does not provide any suggestion, motivation or teaching as to why the "Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing" should be combined with the other two references to make obvious the independent claims. The Office Action only implies in the second full paragraph on page 5 and the next paragraph that the "Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing" can be combined with the other two references simply because it exists. This is an Improper combination.

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Even if suggestion in the prior art existed to include this reference with the other two, the "Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing" does not include the missing teachings of the WebTurboTax article.

None of the references in the rejection of the independent claims 19 and 28 include the features of "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies an expected tax form the user is expected to file" set forth in the independent claims. Thus, this feature would be missing from any proposed combination of "WebTurboTax;" in view of United States, Internal Revenue Bulletin Announcement 99-79; and in further view of the article "Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing." Therefore, the independent claims are patentably distinguishable from the prior art. Applicant respectfully request removal of the rejection of independent claims 19 and 28 based on 35 U.S.C. 103(a).

#### **Claims 20-24 and 29-33**

Claims 20-24 and 29-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over the article "'WebTurboTax' and the United States, Internal Revenue Bulletin Announcement 99-79; and the article 'Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing' as applied to claims 19 and 28 above, and further in view of Miller." Applicant respectfully traverses this rejection. Claims 20-24 depend from claim 19 and claims 29-33 depend from claim 28. Both independent claims 19 and 28 have been shown to be patentable above. The additional reference Miller in this combination is directed to the government entity receiving a tax payment, among other things.

Miller does not show, and the prior art does not suggest the missing features of "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies an expected tax form the user is expected to file" set forth in the claims. This feature would be missing from any proposed combination of the references. Therefore, the independent claims are patentably distinguishable from the prior art. Applicant respectfully request removal of the rejection of claims 20-24 and 29-33 based on 35 U.S.C. 103(a).

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#### **Claims 25-26 and 34-35**

Claims 25-26 and 34-35 were rejected under 35 U.S.C. 103(a) as being unpatentable over the article "'WebTurboTax' and the United States, Internal Revenue Bulletin Announcement 99-79; and the article 'Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing' as applied to claims 19 and 28 above, and further in view of Internal Revenue Bulletin Rec. Proc. 98-51." Applicant respectfully traverses this rejection. Claims 25-26 depend from claim 19 and claims 34-35 depend from claim 28. Both independent claims 19 and 28 have been shown to be patentable above. The additional reference "Bulletin 98-51" in this combination is directed to formatting and sending notification to a mail server, among other things.

Bulletin 98-51 does not show, and the prior art does not suggest the missing features of "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies an expected tax form the user is expected to file" set forth in the claims. This feature would be missing from any proposed combination of the references. Therefore, the claims are patentably distinguishable from the prior art. Applicant respectfully request removal of the rejection of claims 25-26 and 34-35 based on 35 U.S.C. 103(a).

#### **Claims 27 and 36**

Claims 27 and 36 were rejected under 35 U.S.C. 103(a) as being unpatentable over the article "'WebTurboTax' and the United States, Internal Revenue Bulletin Announcement 99-79; and the article 'Internal Revenue Service Selects VeriSign to Secure Electronic Tax Filing' as applied to claims 19 and 28 above, and further in view of Stewart." Applicant respectfully traverses this rejection. Claim 27 depends from claim 19 and claim 36 depends from claim 28. Both independent claims 19 and 28 have been shown to be patentable above. The additional reference Stewart in this combination is directed to an identity of the user stored as a digital certificate, among other things.

Stewart does not show, and the prior art does not suggest the missing features of "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies an expected tax form the user is expected to file" set forth in the claims.

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This feature would be missing from any proposed combination of the references. Therefore, the claims are patentably distinguishable from the prior art. Applicant respectfully request removal of the rejection of claims 27 and 36 based on 35 U.S.C. 103(a).

With this response, Applicant has traversed the rejection and has demonstrated that all of the pending claims are patentably distinguishable over the multiple combinations of references in the Office Action. Accordingly, Applicant respectfully requests removal of all of the rejections, and for favorable action and allowance of the application.

**CONCLUSION**

Applicants respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7340. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees, including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-357601).

Respectfully submitted,

By 

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